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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,810	02/09/2004	Thomas Hofbrucker	DT-6756	9681
30377	7590	06/13/2005	EXAMINER	
DAVID TOREN, ESQ. SIDLEY, AUSTIN, BROWN & WOOD, LLP 787 SEVENTH AVENUE NEW YORK, NY 10019-6018			DURAND, PAUL R	
			ART UNIT	PAPER NUMBER
			3721	

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/775,810

Applicant(s)

HOFBRUCKER ET AL.

Examiner

Paul Durand

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2005.
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-8 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 09 February 2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olvera et al (US 5,897,045) in view of Lin (US 6,779,697).

In regard to claims 1-3, Olvera discloses the invention substantially as claimed including a tool 10, pipe arrangement comprised of fall pipe in the form of slot 20, guide tube 30, driver 20, head piece 50, arranged at outlet 59, and holding device 54, which receives fasteners 4 (Fig.1 and C5,L20 – C6,L37). What Olvera does not disclose is the ability to rotate a headpiece relative to the rest of the device. However, Lin teaches that it is old and well known in the art to provide a rotating head and guide member in the form of barrel 6, which rotates to at least two rotating positions of substantially 90° and relative to a pipe in the form of sleeve 4 for the purpose of operating the tool around an obstacle (see Fig.2 and C2,L16 – C3,L29). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Olvera with the rotating means as taught by Lin for the purpose of operating the tool around an obstacle.

In regard to claims 4-7, the modified invention of Olvera discloses the invention substantially as claimed including a locking device comprised of hole 42 in a head piece

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4, locking body comprised of a ball bearing 52, pressed against rotating head and guide member 6, engaging two receptacles 610 and biased by coil springs 51 for the purpose of operating the tool around an obstacle (see Figs. 2,7,9,10 and C2,L16 – C3,L29).

Furthermore, while the modified invention uses a coil spring, the examiner takes Official Notice that it would have been an obvious matter of design choice to use a leaf spring in lieu of a coil spring for the purpose of holding a locking member in place.

In regard to claim 7, the modified invention of Olvera discloses the invention substantially as claimed including a locking device comprised of a setscrew 530 for the purpose of operating the tool around an obstacle (see Fig. 9).

3. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Olvera et al and Lin in view of Caringella et al (US 6,761,299).

The modified invention of Olvera discloses the invention substantially as claimed except for a locking pin to retain the head member on the tool. However, Caringella teaches that it is old and well known in the art to provide a pin in the form of screw 182, which attaches to key 184 and into hole 188 for the purpose of retaining a head portion on a rotating tool (see Fig.8). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the modified invention of Olvera with the pin retaining means as taught by Caringella for the purpose of retaining a head portion on a rotating tool.

Response to Arguments

4. Applicant's arguments filed 3/10/05 have been fully considered but they are not persuasive.

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Applicant argues that Lin does not show a headpiece being rotated relative to a pipe arrangement and the rest of the drive in device. The examiner disagrees with this argument. First, Lin clearly teaches that it is well known in the art to provide rotation means on a tool to allow a user to access various angles with the tool during operation. Lin is being relied on for this rotational means. The examiner also asserts that there is sufficient motivation for combining the teaching of Lin, with the primary reference of Olvera. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Lin clearly suggests that there is a need in the tool driving art to provide some sort of rotation means on a tool to allow a user to access spaces previously unreachable by prior art tools.

Therefore, for the reason indicated above, the rejection is deemed proper.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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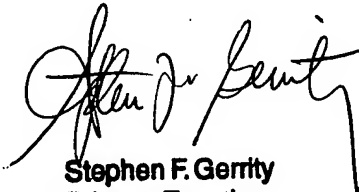
TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Durand whose telephone number is 571-272-4459. The examiner can normally be reached on 0730-1800, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Durand
June 8, 2005


Stephen F. Gerrity
Primary Examiner
571-272-4460